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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,567	04/05/2002	Jonathan Richard Anthony Roffey	040283-0196	4959

7590

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EXAMINER

ANDERSON, REBECCA L

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/009,567	<b>Applicant(s)</b> ROFFEY ET AL.	
	<b>Examiner</b> Rebecca L Anderson	<b>Art Unit</b> 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 17-21, 24-26, 28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-14, 17-21, 24-26, 28 and 29 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other:  |

**DETAILED ACTION**

Claims 1-14, 17-21, 24-26, 28 and 29 are currently pending in the instant application.

***Election/Restrictions***

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Due to the numerous and widely divergent variables in substituent A and the numerous and widely divergent methods of use present, a precise listing of inventive groups cannot be made. The following groups are exemplary:

**Group I**, claim(s)1-14, 17-21, 24-26, 28 and 29 drawn to a product of the formula

(I) wherein:

R1, R2, R3, R4 and R5 are as found in claim 1,

R6 and R7 are independently selected from hydrogen and alkyl and

A is phenyl,

a process for the preparation of the product and a methods of treatment of obesity.

**Group II**, claim(s)1-14, 17-21, 24-26, 28 and 29 drawn to a product of the formula (I) wherein:

R1, R2, R3, R4 and R5 are as found in claim 1,

R6 and R7 are independently selected from hydrogen and alkyl and

A is phenyl,

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a process for the preparation of the product and a methods of treatment of depression.

**Group III**, claim(s)1-14, 17-21, 24-26, 28 and 29 drawn to a product of the formula (I) wherein:

R1, R2, R3, R4 and R5 are as found in claim 1,

R6 and R7 are independently selected from hydrogen and alkyl and

A is tetrahydropyridinyl,

a process for the preparation of the product and a methods of treatment of obesity.

**Group IV**, claim(s)1-14, 17-21, 24-26, 28 and 29 drawn to a product of the formula (I) wherein:

R1, R2, R3, R4 and R5 are as found in claim 1,

R6 and R7 are independently selected from hydrogen and alkyl and

A is tetrahydropyridinyl,

a process for the preparation of the product and a methods of treatment of depression.

**Group V**, claim(s)1-14, 17-21, 24-26, 28 and 29 drawn to a product of the formula (I) wherein:

R1, R2, R3, R4 and R5 are as found in claim 1,

R6 and R7 are independently selected from hydrogen and alkyl and

A is 2,3-dihydro-1,4-dioxin,

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a process for the preparation of the product and a methods of treatment of obesity.

**Group VI**, claim(s)1-14, 17-21, 24-26, 28 and 29 drawn to a product of the formula (I) wherein:

R1, R2, R3, R4 and R5 are as found in claim 1,

R6 and R7 are independently selected from hydrogen and alkyl and

A is 2,3-dihydro-1,4-dioxin,

a process for the preparation of the product and a methods of treatment of depression.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Again, this list is not exhaustive as it would be impossible under the time constraints due to the sheer volume of subject matter instantly claimed. Therefore, applicant may choose to elect a single invention (a product, a method of preparation and a method of use) by identifying another specific embodiment not listed in the exemplary groups of the invention and examiner will endeavor to group the same. The applicant may also choose to elect a single disclosed species along with a single method of use and the examiner will endeavor to create a group comprising the elected species.

The claims herein lack unity of invention under PCT rule 13.1 and 13.2 since, under 37 CFR 1.475(a) the compounds defined in the claims lack a significant structural element qualifying as the special technical feature that defines a contribution over the prior art. The compounds claimed contain an N-aminoethyl indoline, which does not

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define a contribution over the prior art (as can be seen by formula (I) in US Patent No. 5,633,276). The variables on the N-aminoethyl indoline vary extensively and when taken as a whole result in vastly different compounds. Accordingly, unity of invention is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper. Additionally, the vastness of the claimed subject matter, and the complications in understanding the claimed subject matter imposes a serious burden on any examination of the claimed subject matter.

Furthermore, even if unity of invention under 37 CFR 1.475(a) is not lacking, under 37 CFR 1.475(b) a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and a process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or
- (5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

And, according to 37 CFR 1.475(c)

if an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b), unity of invention might not be present.

Therefore, since the claims are drawn to more than a product and more than a method of use, and according to 37 CFR 1.475 (e)

the determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

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The claims lack unity of invention and should be limited to only a product, a process for the manufacture of the said product, and a use of the said product.

### Conclusion

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Rebecca L. Anderson whose telephone number is (703) 605-1157. Mrs. Anderson can normally be reached Monday through Friday 7:00AM to 3:30PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Joseph McKane, can be reached at (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone numbers are (703) 308-1235 and (703) 308-0196.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45AM to 4:45PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4242, (703) 305-3592, and (703) 305-3014.



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